

REMARKS

Upon entry of this paper, claims 1, 22, 37-41 have been amended, claims 2-11, 13-14, 18-20, 23-29, 31-36, 42-72, 74, and 76-78 cancelled (without prejudice or disclaimer), and new claims 86-90 have been added. Thus, claims 1, 12, 15-17, 21-22, 30, 37-41, 73, 75 and 86-92 are presently pending in this application. No new matter has been added.

Allowable Subject Matter

Applicants kindly thank Examiner Morris for acknowledging that Claim 1 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 and if rewritten directed solely to the subject matter indicated as being examined.

Applicants also thank Examiner Morris for acknowledging that Claims 2-4, 22-25, 37, 39 and 75 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims and if rewritten to be directed solely to the elected compounds.

Applicants also thank Examiner Morris for acknowledging that Claims 15-19, 21, 26-31, 38, 40, 41 and 73 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rewritten to be directed solely to the elected compounds.

Claim Amendments

Applicants note that the Examiner has indicated that Claim 1 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112 and if rewritten directed solely to the subject matter indicated as being examined. Claim 1 has been amended to provide that, in addition to the allowable subject matter indicated as being examined, that X is alternatively CO, A is alternatively alkyl, and Y is alternatively $-(CH_2)_n-E-(CH_2)_m-L-(CH_2)_k$ wherein E is an O radical, and k, m and n are individually and independently 0, 1, 2 and 3. Applicants respectfully request that the Examiner extend the examination of Markush-type claim 1 to cover this species to determine its patentability in accordance with MPEP 803.02, which provides that “should the Examiner determine that the elected species is allowable in a Markush claim, the examination of the Markush-type claim

will be extended.” New claims 87-92 also read on this species. Support for the foregoing amendment can be found throughout the original application as filed, and in particular in original claim 1 of the application as filed, as well as in original claim 40 wherein R₁₄ is or 3,3-dimethylbutyryl, R₁₅ is 4-methoxy-pyridin-2-ylamine, and R₁₇ is 1-methyl cyclohexyl. Accordingly, Applicants respectfully request that the Examiner conduct a search and examination of the subject matter of amended claim 1, and new claims 87-90.

The pending claims have also been amended to remove all references to the phrases “optionally substituted”, “substituted”, and “derivatives”.

Claims 39-41 have been amended to reverse a previous amendment which excluded certain subject matter from the claims. Support for the foregoing amendment can be found in throughout the application as filed, and the original claims.

No new matter has been added by way of the foregoing amendments.

I. Rejections under 35 USC § 112, First Paragraph

Rejection of Claims 1, 22-25, 37 and 39

Claims 1, 22-25, 37 and 39 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office Action alleges that the expressions “optionally substituted”, “substituted” and “derivatives” are employed with considerable abandon with no indication given as to what the groups really are and that the specification lacks direction or guidance for placing all of the alleged products in the possession of the public without inviting more than routine experimentation. Specifically, the Office Action states that the working examples do not support any and all substitution and all unknown derivatives as recited in claim 37.

By way of the present amendment, Applicants have cancelled claims 23-25; thus, any rejections with respect to these claims are rendered moot.

Without acquiescing to any basis of the rejection, and solely to expedite prosecution and allowance of the application, Applicants have amended claims 1, 22, 37 and 39 to remove the phrases “optionally substituted”, “substituted” and “derivatives”.

In view of the foregoing, Applicants respectfully submit that the rejection of claims 1, 22, 37 and 39 under 35 USC § 112, first paragraph, are now moot.

I. Rejections under 35 USC § 112, Second Paragraph***Rejection of Claims 1, 22-25, 37 and 39***

Claims 1, 22-25, 37 and 39 stand rejected under 35 USC § 112, second paragraph, as allegedly indefinite for failing to distinctly claim the subject matter which the Applicants regard as their invention. Specifically, the Office Action alleges that the expressions “substituted”, “optionally substituted” and “derivatives” are indefinite to their meaning. The Office Action also objects to the use of the phrase “comprising” in claim 1.

By way of the present amendment, Applicants have cancelled claims 23-25; thus, any rejections with respect to these claims are rendered moot.

Without acquiescing to any basis of rejection, and solely to expedite prosecution and allowance of the application, Applicants have:

- amended the presently pending claims to remove the phrases “substituted”, “optionally substituted” and “derivatives”; and
- amended claim 1 to remove the phrase “comprising”;

Thus, Applicants respectfully submit that amended claims 1, 22, 37 and 39 are unambiguous and distinctly claim the subject matter that the Applicants regard as their invention, and that there is certainty with respect to their scope (MPEP § 2171). In view of the foregoing, reconsideration and withdrawal of the rejection of claims 1, 22, 37 and 39 under 35 USC § 112, second paragraph, are respectfully requested.

Rejection of Claims 2-4 and 75

Claims 2-4 and 75 stand rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for allegedly failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends. By way of the present amendment, Applicants have cancelled claims 2-4; thus, any rejections with respect to these claims are rendered moot. The Office Action alleges that no antecedent basis can be found for a salt in claim 75.

Applicants respectfully traverse the rejection of claim 75.

Applicants submit that claim 75 is in proper dependent form and that there is no antecedent basis issue with respect to this claim. One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. MPEP 608.01(n); 37 CFR 1.75(c). Claim 75 depends from claim 73 which depends from claim 1. Claim 1 recites a compound of formula I. Claim 73 refers back to and further limits claim 1 by reciting a pharmaceutical composition comprising a compound according to claim 1 and a pharmaceutically acceptable carrier, diluent or excipient. Claim 75 refers back to and further limits claim 73 by reciting that the compound is present as a pharmaceutically acceptable salt. Thus, claim 75 is in proper dependent form.

Moreover, Applicants respectfully submit that recitation of a compound in claim 73 provides sufficient antecedent basis for the claim 75 limitation of “wherein the compound is present as a pharmaceutically acceptable salt.” Applicants further submit that because the limitation of “a pharmaceutically acceptable salt” is introduced for the first time in claim 75 with the article “a”, there is no antecedent basis issue in claim 75.

In view of the foregoing, reconsideration and withdrawal of the rejection of claim 75 under 35 USC § 112, fourth paragraph, is respectfully requested.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that the application is in condition for allowance. If the Examiner believes that a telephone call would be useful in expediting the allowance of the application, the Examiner is invited to contact the undersigned.

Applicants believe that no fees are due for the response other than the fees provided for on the accompanying transmittal. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-3655 under Order No. SHIR-502-301.

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Respectfully submitted,

/Lisa M. Treannie/

By _____

Lisa M. Treannie, Esq.
Registration No.: 41,368
Morse, Barnes-Brown & Pendleton, P.C.
Reservoir Place
1601 Trapelo Road, Suite 205
Waltham, MA 02451
781-622-5930
Attorneys for Applicant